

REMARKS

Assignee requests the Examiner consider the following remarks upon further review of the current application.

Claim Amendments

Claim 110 is amended to add the limitation that the instructions of the computer readable medium include “communicating the at least one request” to at least one seller providing the goods/services needed for the project. Also, claim 110 is amended to reflect the at least one request comprises “information derived from the at least one or more parameters, the information comprising at least one datum not among the at least one or more parameters.”

Claim 113 is amended to reflect the insertion of the instruction for communicating the at least one request into independent claim 110.

Claims 116 and 164 are amended to reflect the at least one request comprises “information derived from the at least one parameter, the information comprising at least one datum not among the at least one parameter,” in a fashion similar to claim 110.

Claim Rejections Under 35 U.S.C. § 101

The Examiner has rejected claims 110-121 and 164-172 under 35 U.S.C. § 101 as lacking patentable utility. More specifically, the Examiner contends that the indicated claims lack patentable utility because they “claim the manipulation of data but perform no concrete, useful or tangible result” (page 4 of the Office action). As amended, independent claim 110 now recites the limitation of “communicating the at least one request to at least one seller providing the goods/services needed for the project.” Independent claims 116 and 164 recite similar limitations as originally presented. Upon entry of the present claim amendments, Assignee asserts that claims 110, 116 and 164 now are directed to a concrete, useful and tangible result, as required under 35 U.S.C. § 101.

In addition, as claims 111-115 depend from independent claim 110, they incorporate the limitations of claim 110. Further, claims 117-121 depend from independent claim 116, thus incorporating the limitations of claim 116. Also, claims 165-172 include the limitations of independent claim 164, from which they depend. Thus, claims 111-115, 117-121 and 165-

172 are also directed to a concrete, useful and tangible result. Assignee believes that for at least this reason, claims 110-121 and 164-172 are allowable under 35 U.S.C. § 101. Assignee therefore respectfully requests the Examiner withdraw the rejection under 35 U.S.C. § 101 of these claims.

Claim Rejections for Lack of Novelty - 35 U.S.C. § 102 - Primavera

Claims 110-121 and 164-172 stand rejected by the Examiner under 35 U.S.C. § 102(e) as anticipated by a joint press release by Primavera Systems, Inc. and PurchasePro.com, Inc, featured in Business Wire, 9/21/99, p. 203 (hereinafter “Primavera”). In light of the amendments to claims 110 and 164, Assignee respectfully traverses the rejection.

First, Assignee respectfully contends only published patent applications filed in the United States, or patents granted on applications filed in the United States, may serve as references under 35 U.S.C. § 102(e). As a result, Assignee believes the rejection based upon Primavera, a press release, should be withdrawn, and respectfully requests the Examiner to do so.

Second, assuming the Examiner wishes to assert Primavera as a basis for rejection of the claims under another subsection of 35 U.S.C. § 102, Assignee believes such a rejection would be rendered moot at least in light of the claim amendments presented herein. Specifically, claim 110, as amended, further provides for “the at least one request comprising information derived from the at least one or more parameters, the information comprising at least one datum not among the at least one or more parameters.” Primavera does not so teach. Independent claims 116 and 164 have been amended in a manner similar to that of claim 110. Therefore, Assignee asserts that each and every claim set forth in claims 110, 116 and 164 is not anticipated by Primavera.

With respect to the rejection of claims 111-115, 117-121 and 165-172, these claims depend from patentably distinct independent claims 110, 116 and 164, respectively, and thus incorporate the limitations of their associated independent claims. Accordingly, these dependent claims are also patentable. Assignee makes this statement without reference to, or surrendering, the additional bases for patentability within each dependent claim. Assignee therefore respectfully requests the Examiner withdraw his rejection of claims 110-121 and 164-172.

Claim Rejections for Lack of Novelty - 35 U.S.C. § 102 - Huberman

The Examiner has also rejected claims 110-121 and 164-172 as anticipated by U.S. Patent No. 5,826,244 to Huberman (hereinafter “Huberman”) under 35 U.S.C. § 102(e). Assignee respectfully traverses the rejection in light of the claim amendments to claims 110, 116 and 164 presented herein.

Specifically, Huberman does not disclose the conversion of “the at least one or more parameters into at least one request for goods/services needed to complete the project, the at least one request comprising information derived from the at least one or more parameters, the information comprising at least one datum not among the at least one or more parameters...,” as required in claim 110. Instead, Huberman discloses “[a] system and method to enable and facilitate networked, automated, brokered auctioning of document services.” (Please see Abstract.) In particular, “customer process 210a generates a job request for a document service that is to be the subject of the auction (step A), specifying the particulars of the document service in appropriate detail.” (Please see col. 10, lines 6-9.) As in Primavera, no indication is made in Huberman that a conversion from a set of parameters to a request, as set forth in amended claim 110, is taking place. Claims 116 and 164 also require a similar conversion step. Thus, for at least these reasons Assignee contends that claims 110, 116 and 164 are allowable in view of the current amendments to those claims.

Further, with respect to the rejection of claims 111-115, 117-121 and 165-172, these claims depend from patentably distinct independent claims 110, 116 and 164, respectively, and thus incorporate the limitations of their associated independent claims. Accordingly, these dependent claims are also patentable. Assignee makes this statement without reference to, or surrendering, the additional bases for patentability within each dependent claim. Assignee, therefore, respectfully requests the Examiner withdraw his rejection of claims 110-121 and 164-172.

Conclusion

Assignee believes that all claims presently pending are allowable in view of the references cited in the Office action. Withdrawal of all rejections made by the Examiner is respectfully requested.

Assignee hereby requests a three-month extension of the period for response, thereby extending the due date of this response from February 26, 2004, to May 26, 2004. A check in the amount of \$950.00 is enclosed. Assignee believes that no additional fees are due with respect to this filing. However, should the Office determine that a fee is necessary, or that an overpayment has been made, the Office is hereby authorized to charge or credit deposit account no. 04-1415 accordingly.

Dated this 25th day of May, 2004

Respectfully submitted:



Kyle J. Way
Attorney for Assignee
USPTO Reg. No. 45,549
DORSEY & WHITNEY LLP
370 Seventeenth Street, Suite 4700
Denver, Colorado 80202-5647
Tel.: (303) 352-1171
Fax: (303) 629-3450

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